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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------------|------------------|
| 10/657,232 | 09/09/2003 | Hiroshi Shingai | P24175 | 8832 |
| 7055 7590 03/09/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | EXAMINER ANGEBRANDT, MARTIN J | |
| | | | ART UNIT 1756 | PAPER NUMBER |

| SHORTENED STATUTORY PERIOD OF RESPONSE | NOTIFICATION DATE | DELIVERY MODE |
|--|-------------------|---------------|
| 3 MONTHS | 03/09/2007 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/09/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

| | | | |
|------------------------------|--|---------------------------------------|--|
| Office Action Summary | Application No. 10/657,232 | Applicant(s) SHINGAI ET AL. | |
| | Examiner Martin J. Angebranndt | Art Unit 1756 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2, 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The response of the applicant has been read and given careful consideration. The rejection of the previous office action are withdrawn based upon the amendment. Due to the statement of common ownership, Shingai et al. '894 is not available under 102(e) for a 103 rejection.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2, 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Shingai et al. '894.

4. See claim 2 which includes by reference the limitations of claim 1 which recites the presence of SbTe and Mn, where Mn is present at 20-40% and where claim 2 recites the presence of In and Ge. The instant application in figure 5 shows the peaks recited in the instant claims to be attributable to SbMn and as both Sb and Mn are present, the peaks attributable to them would also expected to be present which the X ray diffraction analysis is done.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1,2,4 and 5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 7083894. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 recites the presence of SbTe and Mn, where Mn is present at 20-40% and claim 2 recites the presence of In and Ge. The instant application in figure 5 shows the peaks recited in the instant claims to be attributable to SbMn and as both Sb and Mn are present, the peaks attributable to them would also expected to be present which the X ray diffraction analysis is done.

7. Claims 1,2,4 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/824081 (US 2004/0208105) in view of Horie et al. '305.

10/824081 (US 2004/0208105) claims optical recording media including SbTeGeMn where Mn is present in amounts of 10-20%. The recited elements make up 95% or more of the total composition.

Horie et al. '305 teach SbTe compositions with a hexagonal structure (figure 1). The addition of In to finely adjust the optical constants and/or suppress nucleation is disclosed.

[0080]. The In may be present in amounts of 2-3 % [0083,0086]

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It would have been obvious to add 2-3% In to the compositions recited in the claims of 10/824081 (US 2004/0208105) in the embodiments where Mn is present in amounts of 18.7 to 20% to finely adjust the optical constants and/or suppress nucleation as taught by Horie et al. '305 with a reasonable expectation of gaining these advantages.

This is a provisional obviousness-type double patenting rejection.

8. Claims 1,2,4 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/809178 (US 2004/0191689) in view of Horie et al. '305.

10/809178 (US 2004/0191689) claims optical recording media including SbTeGeMn where Mn is present in amounts of 5-20%. The recited elements make up 95% or more of the total composition.

Horie et al. '305 teach SbTe compositions with a hexagonal structure (figure 1). The addition of In to finely adjust the optical constants and/or suppress nucleation is disclosed. [0080]. The In may be present in amounts of 2-3 % [0083,0086]

It would have been obvious to add 2-3% In to the compositions recited in the claims of 10/809178 (US 2004/0191689) in the embodiments where Mn is present in amounts of 18.7 to 20% to finely adjust the optical constants and/or suppress nucleation as taught by Horie et al. '305 with a reasonable expectation of gaining these advantages.

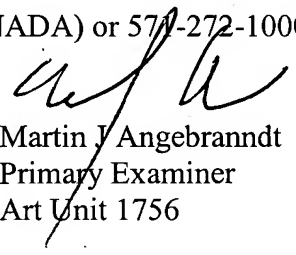
This is a provisional obviousness-type double patenting rejection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebranntdt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Martin J. Angebrannndt
Primary Examiner
Art Unit 1756

3/5/2007